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In re application of :
Christian Kunert, et al. :
Serial No. 10/713,050 :
Filing Date: November 17, 2003 :
For: Use of a Glass for Thermal Shock- :
Resistant Beverage Containers :
:

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR § 1.181, filed March 11, 2005. Petitioner states that the priority and specification objections made final in the office action mailed November 24, 2004, and reiterated in the Advisory Action of February 28, 2005, are improper as based upon incorrect standards.

The instant petition centers upon the term “colorless” and whether this term, as used in the instant claims, has antecedent basis in the specification. Also of issue is whether this term finds sufficient support in the parent application¹ so as to maintain priority of the instant application as a continuation. Because the issue of priority will stand or fall with the issue of antecedent basis, the latter issue will be taken up first.

The petitioner states that both the instant specification and that of its parent are identical with both providing inherent support for the term “colorless.” Although a previous BPAI decision (Appeal No. 2003-0694) determined that the specification of the parent application did not support the terminology “colorless,” the petitioner argues that the declaration and exhibit entered into the instant case on October 22, 2004 provide sufficient evidentiary basis for inherent support. This is not convincing for at least the reasons below.

As set forth in the table on page 2 of the declaration, a wet analysis of the inventive glass (having a composition within the ranges set forth in instant claim 1) shows that the glass comprises 0.035 wt% Fe₂O₃. It is notoriously well known in the glass art² that even minor amounts of Fe₂O₃ present in a glass will tend to color the glass with a green cast. This fact is supported by the petitioner’s own specification.³ Furthermore, upon examination of the evidence provided by the petitioner (a glass beaker formed of the glass having the composition described in the table on page 2 of the declaration), a green/grey edge coloration can be clearly seen. As such, the

¹ U.S. Patent Application Serial No. 09/532,966, filed March 22, 2000, now abandoned.

² See, e.g., U.S. Patent No. 5,030,594 at column 1, lines 16-20, which discloses, “. . . sufficient amounts [of iron oxide] to produce a green coloration are usually present as impurities from the raw material from which the glass is melted.”

³ See, page 3, lines 15-24.

petitioner's argument that the specification provides inherent support (and antecedent basis) for the term "colorless," is unconvincing.

We now turn to the issue of priority. As set forth in 37 C.F.R § 1.75(d)(2):

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

Because of the lack of clear support in the specification for the term "colorless," an amended disclosure to include "colorless" would be required in order to provide support for "colorless" in the claims. Because such an amendment to the specification would render the instant application a continuation-in-part (rather than a continuation, as currently designated), the effective filing date for the instant claims would be November 17, 2003.

The petition is **DENIED**.

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